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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 25

Application Number: 09/449,237

Filing Date: November 24, 1999

Appellant(s): CURRY, JAMES PRESCOTT

Craig F. Taylor
For Appellant

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EXAMINER'S ANSWER

Technology Center 2100

This is in response to the appeal brief filed on October 6, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 81 and 93 stand or fall together, that claims 88, 89, 91, and 92 stand or fall together, and that the remaining claims 82, 83, 84, 85, 86, 87, 90, 95, 96, and 97 do not stand or fall together, and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

5,954,640	Szabo	9-1999
5,678,041	Baker et al.	10-1997

5,890,997 Roth 4-1999

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claims 81 and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker et al. (U.S. Patent No. 5,678,041, hereinafter “Baker”).

In considering claim 81, Baker discloses a method of providing services through a publicly accessible distributed network (100) to authorized users using authorized portals (107-109), comprising:

providing an online site that enables databases to be accessed from one of multiple portals (col. 4, lines 18-35);

placing at least one of the multiple portals to the online site in communication with the on-line site through the publicly accessible distributed network (col. 4, lines 18-35), wherein the network includes the internet, and wherein at least one of the computers can access the site through the Internet (col. 3, lines 12-15);

receiving a request at the online site requesting access to the databases (col. 4, lines 17-19);

processing the request to determine which portal the request came from (col. 4, lines 9-12, 17-19, "ID107, ID108, ID109," "identity of the requesting user terminal"), and whether the request was received from an authorized user (col. 4, lines 24-30, "user clearances 107-109"); and

responding to the request based on which portal the request came from and whether the request was received from an authorized user (col. 4, lines 17-30).

However, Baker does not expressly disclose using the online system for wellness services at a fitness center, wherein one of the multiple computers is a computer residing at the fitness center and is thus sponsored by the fitness center. Nonetheless, the claim limitations that the database is a wellness-related database, and that one of the computers may be at a fitness center, and thus would be sponsored by the fitness center, are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The use of the Baker system for fitness data in a fitness center is merely a field of use of the invention. It would make no difference if one of the computers were at a school or business (as disclosed by Baker – col. 1, lines 46-55), a health center, a neighbor's house, a library, or any other location, or if the data was wellness-related, financial-related, or adult-material-related. The terminal ID determination and the authorization steps would be performed the same regardless of the type of information being accessed or the location of the requesting computer. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include any type of information and to place one of the terminals at any location in the system taught by Baker, because access to any type of personal or explicit information should be restricted to prevent tampering or unauthorized access. The subjective type of information and location does not functionally relate to the operational steps in the method claimed, and thus does not patentably distinguish the claimed invention.

Claim 93 contains **no further limitations** over claim 81, except that a different *level* of services are provided to the user based at least in part on the results of determining which portal the request came from. Nonetheless, this feature is taught in col. 4, lines 9-30 of Baker (“unlimited access, restricted use . . .”). Although Baker does not disclose that the sponsored portal is located in a health or fitness center, that claim limitation does not functionally relate to the operational steps in the method claimed, and thus does not patentably distinguish the claimed invention, as discussed above.

2. Claims 82-92 and 95-97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker, in view of Szabo (U.S. Patent No. 5,954,640).

In considering claim 82, although the system taught by Baker discloses substantial features of the claimed invention, it fails to disclose obtaining data from the user through one of the portals, and then providing the user with access to the data through the other terminal. However, these features are well known for online sites, and

particularly for wellness-related sites, as evidenced by Szabo. In a similar art, Szabo discloses a system for accessing an online wellness-related site, wherein users can enter information into the site to be stored at a database, and wherein the user can later retrieve that data from one of many computers (including a sponsored kiosk). See col. 6, lines 5-9; col. 3, lines 56-61. Thus, given the teaching of Szabo, a person having ordinary skill in the art would have readily recognized the desirability and advantages of allowing users to input data, as taught by Szabo, into the information access system taught by Baker, to allow greater interactivity among users, thus providing greater opportunity for market growth of the online site. Therefore, it would have been obvious to allow inputting data into the system, as taught by Szabo, in the system taught by Baker. In addition, both Szabo and Baker teach that multiple computers can be used to retrieve data (see Baker, Fig. 1) and/or to input data (see Szabo, col. 4, lines 16-23).

In considering claim 83, Szabo further discloses automatically assigning the user to a control group based on user attributes (col. 9, line 66 – col. 10, line 9; “the models themselves may be adaptive based on the experiences of individual users or groups . . . neural network technology and other adaptive paradigms may be employed to dynamically improve the models through use and feedback.”).

In considering claim 84, Szabo further discloses providing fitness advice and goals to the group, wherein the advice and goals are at least in part a result of the group result data (col. 10, lines 1-34).

Claim 85 contains no further functional limitations over claims 81 and 82 combined and is rejected for the same reasons as stated above. Although the amendment to claim 85 has added that authorized users are able to enter fitness-related data "selected from the group consisting of workout plans, workout goals, weight training plans, weight training weights and weight training repetitions," this information is again non-functional, descriptive material that does not add to the functional operation of the claimed invention. The entered data could have been any data (i.e. business plan data, school-related program data, etc.) and the invention would still perform the same function – that is, allowing data to be entered at one portal in the system, and allowing retrieval and viewing of the data at a different portal.

In considering claim 86, Baker discloses a method of providing services to an authorized user through a distributed communications network, comprising:

identifying a portal with a portal identifier (ID107, ID108, ID109), and storing the portal identifier in a database (col. 4, lines 20-22);

receiving a request from the portal by an online site, and processing the request at a controller to determine whether the request was from the portal (col. 4, lines 1-16); and

assigning an access code to the user (clearance 107, clearance 108, clearance 109), the access code defining a level of services available to the user, and then providing services to the user through the distributed network that correspond to the user's access code (col. 4, lines 25-32).

However, Baker fails to disclose the use of the access system for wellness-related information and services, and Baker further fails to disclose providing at least one control group, wherein each control group includes at least one authorized user, and assigning the user to one of the control groups, wherein the assigning is done automatically based on user attributes. Nonetheless, the use of user authorization routines for wellness related sites is well known, as evidenced by Szabo. In a similar art, Szabo discloses a wellness-related site that provides wellness-related access and services to users, wherein the users must identify themselves before gaining access to the data (col. 13, lines 43-47, 55-57, "safeguards are also placed to prevent unauthorized intrusion into an individual's personal information records"). Thus, it would have been obvious to a person having ordinary skill in the art to use the safeguards taught by Baker for a wellness-related site, such as taught by Szabo, because users would not want others to know their personal medical and health information.

Szabo further discloses providing at least one control group, wherein each control group includes at least one authorized user, and assigning the user to one of the control groups, wherein the assigning is done automatically based on user attributes (col. 9, line 66 – col. 10, line 9; wherein a neural network may be employed to dynamically update the group information through the use of a feedback loop). See also, col. 10, lines 20-25 ("the consumer may review information relating to others who consume the specific nutritional supplement [i.e. the control group], or others who suffer the same undesired side effect. This will allow the consumer to benefit from the experiences of others by potentially allowing a change in nutritional

supplementation..."), col. 10, lines 1-2 (wherein users are automatically assigned to the control groups based on their attributes - "the models themselves may be adaptive based on the experiences of individual groups of users [i.e. user attributes]"") and col. 10, lines 14-15, (wherein "automated systems may be used" to review feedback and adapt the control group).

In considering claim 87, Szabo further discloses providing information or goods to the user based upon the control group to which the user has been assigned (col. 9, line 66 – col. 10, line 9).

In considering claims 90 and 96, Szabo further discloses that each control group includes group result data, the method further comprising providing the result data to the portal, storing the result data to the group result data for the authorized user's control group, and adjusting the user improvement plan for each user in the authorized user's control group based on the stored group result data (col. 10, lines 1-34).

In considering claim 95, Szabo further discloses creating practical guidelines and advice for the control group, including a user improvement plan selected to be related to the guidelines and advice (col. 10, lines 1-34).

In considering claim 97, Szabo further discloses storing result data for the authorized user, and assigning the user to a new control group based on the stored result data for the user (col. 10, lines 14-34).

3. Claims 88, 89, 91, and 92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker, in view of Szabo, and further in view of Roth (U.S. Patent No. 5,890,997).

In considering claim 88, Szabo further discloses creating practical guidelines and advice for the control group, including a user improvement plan selected to be related to the guidelines and advice (col. 10, lines 1-34).

However, Szabo does not disclose that the guidelines are workout guidelines and the advice is workout advice. Nonetheless, the use of workout data to create practical guidelines and advice for groups of users is well known, as evidenced by Roth. In a similar art, Roth teaches a computerized fitness management system for multiple users at a health club which includes a database storing wellness-related information for each user (cols. 28-30), wherein workout data is used to create practical guidelines and advice for groups of users in the system, and wherein such data can be used to update workout routines and other wellness-related advice in the system (col. 3, lines 47-52, 59-63; col. 4, lines 3-10). Thus, given the teaching of Roth, a person having ordinary skill in the art would have readily recognized the desirability and advantages of allowing updating of the data in the combined teaching of Baker and Szabo based on workout data and results, as taught by Roth, so that medication and other advice can be altered

in response to the current state of a user's health. Therefore, it would have been obvious to change the guidelines and advice in the system taught by Baker and Szabo according to workout results, as taught by Roth.

In considering claim 89, Szabo further discloses that the improvement plan is at least in part based on the collective attributes of the control group (col. 10, lines 1-34). Again, in view of the workout updating features taught by Roth, as discussed above, it would have been obvious to a person having ordinary skill in the art to base a user improvement plan on collective group workout data, so that group advice and information can be based on the current state of the collective users' health.

In considering claim 91, Szabo further discloses checking if the user improvement plan for users in the control group needs to be adjusted (col. 12, lines 45-52). Thus, although an "alarm" is not expressly disclosed, Examiner takes official notice that alarms are notoriously well known in the computer art as a means for reminding or warning users of particular events. Therefore, it would have been obvious to a person having ordinary skill in the art to provide an alarm signal to the system administrator if adjustments are needed, to make a human aware of potentially harmful drug interactions or other health risks.

In considering claim 92, Szabo further discloses storing result data for the authorized user, and assigning the user to a new control group based on the stored result data for the user (col. 10, lines 14-34).

(11) Response to Argument

In response to the arguments set forth in Applicant's Appeal Brief filed on October 6, 2003, the following factual arguments are noted:

- a. The contents of the database, the sponsorship of the portals, and the location of the portals, as claimed, are functionally related to each other, and thus are functionally related to the invention claimed in claims 81 and 93 (as argued under section I of Applicant's Argument). Applicant presents a similar argument with respect to claim 85 (as argued under section II of Applicant's Argument).
- b. Szabo does not disclose automatically assigning users to control groups based on user attributes, as claimed in claim 86 (as argued under section III of Applicant's Argument). Applicant presents a similar argument in arguments I(B) regarding claim 83, I(C) regarding claim 84, I(D), regarding claim 95, I(E) regarding claim 97, I(F) regarding claim 96, III(A) regarding claim 87, III(B) regarding claim 90, and III(C) regarding claims 88, 89, 91, and 92.
- c. Szabo only discloses nutritional supplement information and not fitness information, as required by claim 82 (as argued under section I(A), for example). Applicant presents a similar argument in arguments I(C) regarding claim 84, I(D) regarding claim 95, I(E) regarding claim 97, and I(F) regarding claim 96.

In considering (a), Applicant contends that the contents of the database, the sponsorship of the portals, and the location of the portals, as claimed, are functionally related to each other, and thus are functionally related to the invention claimed in claims 81 and 93, and in claim 85. Examiner respectfully disagrees.

The claims describe two portals that provide access to a database at an online site. A user can access the database through either portal, wherein the response to the request will depend on which portal the request came from and whether the user is authorized. Baker et al. describes all of these features (see col. 3, lines 12-15; col. 4, lines 9-35). The claims further provide that the database is a “wellness-related” database, and that one portal “non-sponsored” while the other is “sponsored by and located at, a fitness center.” Baker does not teach this field of use. Instead, Baker suggests that certain portals could be located at a “school” or “business” where one would want to limit a student or employee’s level of access to information. See col. 1, lines 42-56. Thus, Baker contemplates that sponsored portals (i.e. those located at, and thus sponsored by, a school or business) receive a different level of access as non-sponsored portals (i.e. those located elsewhere – perhaps in a person’s private home). In other words, while Baker discloses the use of the portals at a “school” to access “resources during a class meeting,” and further discloses the use of portals at a “business” to access “work-related resources,” Baker does not discloses the use of portals at a “health center” to access “wellness-related” resources.

Nonetheless, the claim limitation that the sponsored portal is located at a “fitness center” and that the database is a “wellness-related” database does not functionally

affect the operation of the claimed invention. Claims 81 and 93 do not describe using the wellness-related information for any particular purpose or applying the information to any further process. Instead, these claims merely describe that the information is a particular type and that the portal is located at a particular location. Both of these recitations thus constitute fields of use for the invention.

Note that certain of Applicant's claims *do* require a functional relationship between the nature of the data and other claimed steps (see claims 88, 89, 91, and 92, which describe using the wellness-related information to promulgate particular workout guidelines and improvements to health plans). For these claims, Examiner has cited prior art that discloses such a functional relationship. However, for the claims that do not include any functional relationship between the operational steps performed and the nature of the information claimed, the claim recitations for a type of information used and a location of the portal is a non-functional field of use for the invention, and does not patentably distinguish the claimed invention from the prior art. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

In further considering (a), Applicant makes reference to *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 139 F.3d 1368 (Fed. Cir. 1998), and argues that the United States Court of Appeals for the Federal Circuit considers business methods patentable subject matter. See p. 7, line 17 – p. 8, line 13 of Applicant's Appeal Brief. Notwithstanding this ruling, Applicant's argument is moot because the claims at issue do not include a business method. The fact that the

claimed invention is intended for use for fitness data at a sponsoring fitness center does not render the claim a business method. Instead, it only establishes an intended field of use for the invention.

In considering (b), Applicant contends that Szabo does not disclose automatically assigning users to control groups based on user attributes, as claimed in claim 86 and others. Examiner respectfully disagrees.

Szabo discloses a system for providing health-related services and information to users, wherein users are assigned to control groups (col. 10, lines 20-25, “the consumer may review information relating to others who consume the specific nutritional supplement [i.e. the control group], or others who suffer the same undesired side effect. This will allow the consumer to benefit from the experiences of others by potentially allowing a change in nutritional supplementation...”), and are automatically assigned to the control groups based on their attributes (“the models themselves may be adaptive based on the experiences of individual groups of users [i.e. user attributes],” col. 10, lines 1-2, wherein “automated systems may be used,” to review feedback and adapt the control group, col. 10, lines 14-15). Thus, Szabo discloses the control group and automatic assignment limitations claimed in claim 86.

In considering (c), Applicant contends that Szabo only discloses nutritional supplement information and not fitness information, as required by claim 82 and others. Examiner respectfully disagrees with this argument. Szabo in fact discloses that the

system could be used for "activity and exercise" information (col. 5, lines 13-15; col. 10, lines 37-40). Applicant points out that Szabo discloses that including activity and exercise information "are difficult to effect" and "may be of limited benefit" (see Argument I(C)). Nonetheless, however difficult it might be, Szabo still discloses including fitness information in the health and wellness model.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

BE
March 29, 2004

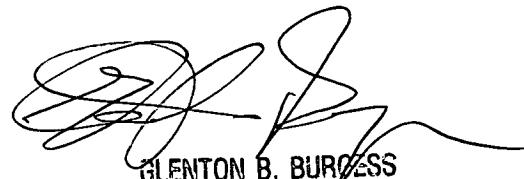
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